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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/
BELLSOUTH I.P. CORP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

EXAMINER

HUSSAIN, TAUQIR

ART UNIT PAPER NUMBER

2196

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,551

Applicant(s)

MALIK, DALE W.

Examiner

Tauqir Hussain

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

1. Claims 1-29 are pending in this application.

Claim Objections

2. Claim 1,14,15,16 recites the limitation "the second recipient" in line 4-5, line 5, lines 4-5, and line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

3. Claim 5,12, 13, 17, 20, 28 and 29, recites the limitation "a second sender" in lines 2-3 and 5-6, lines 4, line 3, line 4, line3 and lines 6-7, lines 3 and 6, line 4. It is not clear how applicant is implying " a second sender" into the IM session. Is this "a second sender" is already engaged with first sender or first recipient or at what point "a second sender" joins the chat session? Applicant has also failed to show any consistency between second recipient and "a second sender" or it is not clear if applicant meant same entity by using terms second recipient and second sender?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-4, 9-11, 14-19 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Coutts et al. (Pub. No.: US 2003/0120805 A1), hereinafter "Coutts".

6. As to claim 1, Coutts discloses, a communication method comprising the steps of:

receiving an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

prompting the first sender for permission to convey the IM message to the second recipient ([0038, lines 14-19] and [0027, lines 5-13]).

7. As to claim 9, Coutts discloses, a communication method comprising the steps of:

receiving an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

conveying the IM message to a second recipient ([0026, lines 10-12]).

8. As to claim 14, Coutts discloses, a communication system comprising:

receive logic configured to receive an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

prompting logic configured to prompt the first sender for permission to convey the IM message to the second recipient ([0038, lines 14-19] and [0027, lines 5-13]).

9. As to claim 15, Coutts discloses, a communication system comprising:

means for receiving an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

prompting the first sender for permission to convey the IM message to the second recipient ([0038, lines 14-19] and [0027, lines 5-13]).

10. As to claim 16, Coutts discloses, a computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines

12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

computer-readable code adapted to instruct a programmable device to prompt the first sender for permission to convey the IM message to the second recipient ([0038, lines 14-19] and [0027, lines 5-13]).

11. As to claim 23, Coutts discloses, a communication system comprising:

receive logic configured to receive an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

conveying logic configured to convey the IM message to a second recipient ([0026, lines 10-12]).

12. As to claim 24, Coutts discloses, a communication system comprising:

means for receiving an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and;

means for conveying the IM message to a second recipient ([0026, lines 10-12]).

13. As to claim 25, Coutts discloses, a computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to receive an instant messaging (IM) message from a first sender to a first recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

computer-readable code adapted to instruct a programmable device to convey the IM message to a second recipient ([0026, lines 10-12]).

14. As to claim 2, Clouts discloses, the method comprising the step of:

receiving an input from the first sender, the input being indicative of the permission to convey the IM message to the second recipient ([0024, lines 2-4, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time], Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers); and

conveying the IM message to the second recipient in response to receiving the input ([0027, lines 5-13]).

15. As to claim 17, the claim is rejected for the same reasons set forth in claim 2 above.

16. As to claim 3, Coutts discloses,

indicating to the first sender that the IM message is being conveyed to the second recipient ([0041, lines 1-13, where communication message is inherently an instant message] and [0013, lines 12-13, where interactive communication is conducted in real time and where response to sender's message itself is a delivery confirmation of a message]).

17. As to claims 10, 18 and 26, the claims are rejected for the same reasons set forth in claim 3 above.

18. As to claim 4, Coutts discloses, the method comprising the step of:

indicating to the second recipient that the IM message originated from the first sender ([0044, lines 1-3, where server/proxy indicating to the second recipient B that the IM message originated from the first sender A]).

19. As to claim 11, 19, 27, the claims are rejected for the same reasons set forth in claim 4 above.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2196

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 5-8, 12-13, 20-22 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coutts.

22. As to claim 5, Coutts discloses, the method of claim 2, further comprising the steps of:

determining whether the first recipient is engaged in an IM chat session with a second sender; and indicating to the first sender, in response to determining that the first recipient is engaged in an IM chat session with a second sender, that the first recipient is engaged in an IM chat session with a second sender ([0041, lines 1-13]).

Coutts do not explicitly disclose, querying first sender about establishing a chat session between first recipient and second recipient or determining first recipient is engaged in chat session with second sender. However, Coutts discloses that all the messaging traffic passes through the messaging server 112 and /or messaging proxy 120 and they both capable of communicating with first and second senders in real time. Coutts also discloses that first sender can communicate or chat with second recipient since user A's message is forwarded to second recipient "B" in the absence of first recipient "D" ([0043, lines 1-5]). It would have been obvious to a person of ordinary skill in the art at the time of the invention to establish a session between first sender and

Art Unit: 2196

second recipient or second sender to first recipient. It will also be obvious that at times role of recipient and sender can be interchangeable. Further, any third party like administrator or proxy/server keeps track of the over all communication traffic, messaging and chat sessions with in systems database.

23. As to claim 12, 20 and 28, the claims are rejected for the same reasons set forth in claim 5 above.

24. As to claim 6, Coutts discloses, the method comprising the step of:

request prompting the first sender for permission ([0031, lines 16-20] and [0038, lines 14-19, where proxy queries the sender whether to forward a message to second recipient]).

Coutts do not explicitly disclose waiting for a predefined time before prompting for permission to forward the message. However, Coutts discloses a table of rules ([0032, TABLE 1]) where rules can be set up as predefined criteria to establish the status of user's status and availability. Therefore, it is obvious from Coutts's teachings that recipient's configuration rules can be set to predefined time in advance to query the sender whether he would like to forward the message to some one else in case of recipients absence.

25. As to claim 21, the claim is rejected for the same reasons set forth in claim 6 above.

26. As to claim 7, Coutts discloses, the method comprising the step of:

indicating to the first sender, in the absence of a response from the first recipient during the predefined time interval, that the first recipient is unavailable ([0038, lines 14-19]).

Coutts do not explicitly disclose, waiting for a predefined time before prompting for permission to forward the message. However, Coutts discloses a table of rules ([0032, TABLE 1]) where rules can be set up as predefined criteria to establish the status of user's status and availability. Therefore, it is obvious from Coutts's teachings that recipient's configuration rules can be set to predefined time in advance to query the sender whether he would like to forward the message to some one else in case of recipients absence.

27. As to claim 22, the claim is rejected for the same reasons set forth in claim 7 above.

28. As to claim 8, Coutts discloses, the method, wherein the step of requesting permission from the first sender is responsive to an absence of an input from the first

recipient during the predefined time interval ([0038, lines 14-19, recipient responses against unavailability of the second recipient]).

29. As to claim 13, Coutts discloses, the method, further comprising the step of:

further indicating to the first sender, in response to determining that the first recipient is engaged in an IM chat session with a second sender, that an IM chat session is being established between the first sender and the second recipient ([0041, lines 1-13]).

Coutts do not explicitly disclose, querying first sender about establishing a chat session between first recipient and second recipient or determining first recipient is engaged in chat session with second sender. However, Coutts discloses that all the messaging traffic passes through the messaging server 112 and /or messaging proxy 120 and they both capable of communicating with first and second senders in real time. Coutts also discloses that first sender can communicate or chat with second recipient since user A's message is forwarded to second recipient "B" in the absence of first recipient "D" ([0043, lines 1-5]). It would have been obvious to a person of ordinary skill in the art at the time of the invention to establish a session between first sender and second recipient or second sender to first recipient. It will also be obvious that at times role of recipient and sender can be interchangeable. Further, any third party like administrator or proxy/server keeps track of the over all communication traffic, messaging and chat sessions with in systems database.

30. As to claim 29, the claim is rejected for the same reasons set forth in claim 13 above.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aravamudan et al. (Patent No.: US 6,301,609 B1) discloses a system, a unified messaging solution and services to located registered users.

Gudjonsson et al. (Patent No.: US 6,564,261B1) discloses a, secure network for users to establish a communication session.

DeCarmo , (Pub. No.: US 2004/0010808 A1) discloses, an automated presence management on an instant messaging network.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tauqir Hussain whose telephone number is 571-272-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El Hady can be reached on 571 272 3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2196

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH


NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER